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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,837	08/16/2007	Ferdinand Koeckerling	72386	5339
23872 7590 04/25/2011 MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227				
EXAMINER				
MASHACK, MARK F				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
04/25/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/599,837

Applicant(s)

KOECKERLING ET AL.

Examiner

MARK MASHACK

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 9-13 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 9-13 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to a communication dated 4/20/2011. Claims 1, 9-13, 16-22 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/20/2011 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claim 1, 9-10, 16-22** is rejected under 35 U.S.C. 103(a) as obvious over **Trabucco (US 6,166,286)** in view of **Zotti et al. ("Zotti" US 2003/0171823)** and **Kurtz et al. ("Kurtz" US 3,286,713)**.

Trabucco discloses of an annular mesh **20** comprising a central opening **22b** and an access slit **24** interrupting an annular path of said first annular mesh layer (Fig 1C). **Trabucco** does not disclose of a second layer.

However, **Zotti** teaches of a two dimensional implant comprising: a first annular mesh layer comprising a central opening **2'** and an access slit **3'** extending through said central opening (Fig 5 and Paragraph 32); and a second congruent mesh layer comprising a second annular opening **2''** and a second annular mesh layer access slit **3''** (Paragraph 32), the access slit of the first and second mesh layer are offset by an angle of 180 degrees (Paragraph 56) and the central opening of each or aligned (Fig 1), wherein the first and second annular mesh layers are joined via connection points being formed in a form of seamed points or bonded points (Paragraphs 41-42).

Additionally, **Kurtz** teaches of a similar device comprising two layers with slits being offset by an angle of 180 degrees (Fig 1) and forming the layers of identical designs (Col 2, Lines 14-17).

Given the teachings of **Zotti** and **Kurtz**, it would have been obvious to provide the mesh of **Trabucco** with the second mesh layer with an offset slit in order to prevent

the spermatic cord from slipping out of the slit. It also would have been obvious to make the mesh from two identical layers in order to simplify the production.

Regarding Claim 9, Zotti teaches of the implant comprising connection points along the inner and outer edges (Paragraphs 41-42). **Regarding Claim 16, 18-19, 21,** the layers are mesh so that there are spaces between the fibers and the "sharp edges without ravel" would only be a problem if there were free ends of the fibers to unravel. Therefore Examiner asserts the welds are applied to individually spaced fibers of each of the mesh layers. **Regarding Claim 17, 20, 22,** "adjacent" is a broad term and either embodiment discussed meets the claim limitations (**Zotti**; Paragraphs 41-42).

Regarding Claims 19, 21, Zotti teaches of the first and second mesh layers are connected only on a common side (Fig 2).

Regarding Claim 10, Trabucco in view of Zotti and Kurtz disclose all of the claimed limitations except for the mesh layers being formed of a laser cut material.

However, laser cutting is a known method of forming the mesh layers.

Therefore, even if "the laser-cut mesh material" results in different structural characteristics of the end product than other molding methods, it still would have been *prima facie* obvious at the time the invention was made to use a "the laser-cut mesh material" material in since it is recognized as a useful technique for forming the mesh material.

5. **Claim 11-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Trabucco** in view of **Zotti, Kurtz** and **Willberg (DE 198 32 634)**..

Trabucco in view of **Zotti, Kurtz** disclose all of the claimed limitations except for the device having a coating containing metal. However, **Willberg** teaches of a similar hernia mesh with a coating containing metal (Col 4, Lines 17-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of **Zotti** with the coating in order to increase the adhesion factor (Col 4, Lines 17-28).

Regarding Claims 12-13, the coating contains titanium and a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK MASHACK whose telephone number is (571)270-3861. The examiner can normally be reached on Monday-Thursday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Mashack/
Examiner, Art Unit 3773